



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,825	11/30/2001	Michael B. Sundel	002250-2	2660

22204 7590 07/13/2004

NIXON PEABODY, LLP  
401 9TH STREET, NW  
SUITE 900  
WASHINGTON, DC 20004-2128

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/996,825

Applicant(s)

SUNDEL, MICHAEL B.

Examiner

Narayanswamy Subramanian

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to applicant's communication filed on March 23, 2004. The amendments to claims 12-14, 19 and 20 and addition of new claim 22 have been entered. Claims 1-22 are currently pending and have been examined. The rejections and response to arguments are stated below.

#### *Claim Rejections - 35 USC § 101*

2. The claims 1-5 and 9 of the invention are directed to non-statutory subject matter. Claim 1 is drawn to a method for facilitating the shipment of a package that is not tied to any technological art. Similarly the dependent claims 2-5 and 9 are not tied to any technological art. Claims 1-5 and 9 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office has taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are "nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution." *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Board Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international

application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 4-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al (US Patent 2002/0032612 A1).

With reference to claim 1, Williams teaches a method for facilitating the shipment of a package containing items from a Sender to a Recipient via a shipping mechanism, the method comprising the steps of: storing package data, including item data, in a database (See Williams Paragraphs 148-150); retrieving shipment tracking data from the shipping mechanism; adding the shipment tracking data to the database (See Williams Paragraphs 148-152); correlating the package data in the database with the shipment tracking data (See Williams Paragraph 149); and permitting an authorized user to query the database (See Williams Paragraphs 28 and 407-410).

With reference to claim 2, Williams teaches a method of Claim 1, further comprising the step of assigning the package to a specific combination of a shipper and shipping method based on the package data (See Williams Figures 12 and 38).

With reference to claims 4-11, Williams teaches the steps wherein the package data includes at least the originating address and the destination address (See Williams Figure 27A), and the item data includes a description of the items in the package (See Williams Paragraph

Art Unit: 3624

150), said method further comprising the step of: using the package data to calculate shipping charges and generate invoices associated with the shipment (See Williams Paragraph 333); wherein the item data includes the description and value of each item (See Williams Paragraph 150); wherein the step of storing package data comprises transmitting package data via the Internet (See Williams Paragraphs 138, 139 and 142); wherein said permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network including the Internet in response to the query parameters (See Williams Paragraphs 138, 139 and 142); further comprising the steps of: adding returned item information to the database if items from the package are returned to the Sender (See Williams Paragraph 150); in the case of international shipments, preparing duty and tax refund claims based on the returned item information and the corresponding item data; and adding duty and tax refund information to the database (See Williams Paragraphs 187, 199, 204, 253 and 254, additional components of refund are interpreted to include duty also); wherein said permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network in response to the query parameters (See Williams Paragraphs 152 and 153); wherein the computer network comprises the Internet (See Williams Paragraphs 142, 152 and 153).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

Art Unit: 3624

matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US Patent 2002/0032612 A1) in view of Riggs et al (US Patent 2002/0065738 A1).

With reference to claim 3, Williams teaches a method of claim 1 as discussed above.

Williams does not explicitly teach the step of determining whether the package requires customs clearance and, if so, generating the appropriate customs documentation or data transmission to a customs broker.

Riggs teaches the step of determining whether the package requires customs clearance and, if so, generating the appropriate customs documentation or data transmission to a customs broker (See Riggs Paragraphs 88-91).

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the step taught by Riggs to the invention of Williams. The combination of the disclosures taken as a whole, suggests that users would have benefited from the convenience of complying with customs regulations in one session using a user-friendly interface.

With reference to claim 12, Williams teaches an apparatus for facilitating the shipment of a package containing items from a Sender to a Recipient, comprising: a processor having a database for storing and processing package data, the package data including item data; a Sender's terminal for selectively communicating with said system processor; a first communications link adapted for selectively enabling communication between said processor and said Sender's terminal, for selectively transmitting the package data from said Sender's terminal to said processor, and for selectively transmitting said package data relating to a

Art Unit: 3624

selected package to said Sender's terminal responsive to a request; a shipper's terminal; and a second communications link for selectively communicating between said system processor and said shipper's terminal. (See Williams Figures 1, 3A, Paragraphs 134-158)

Williams does not explicitly teach a customs facilitator terminal and a third communications link for selectively communicating between said processor and said customs facilitator terminal.

Riggs teaches a customs facilitator terminal; and a third communications link for selectively communicating between said processor and said customs facilitator terminal. (See Riggs Figures 2-11, the logistics provider and Government are interpreted to include a customs facilitator)

It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the teachings Riggs to the invention of Williams. The combination of the disclosures taken as a whole, suggests that users would have benefited from the convenience of having a link with customs facilitator so that the user may comply with customs regulations in one session using a user-friendly interface.

With reference to claims 13-16 and 18-22, Williams teaches a processor is adapted to select a shipping assignment for the package based on information comprising package data (See Williams Figures 12 and 38); wherein said processor is further adapted to generate appropriate shipping documents for the package (See Williams Paragraph 17); wherein said shipping documents comprise package labels (See Williams Figure 27A and Paragraph 71) and shipping manifests (See Williams Paragraph 17, shipping documents are interpreted to include shipping manifests); wherein at least one of said communication links is the Internet (See Williams

Art Unit: 3624

Paragraphs 138, 139 and 142); wherein said processor includes a Web site page selectively accessible via one of said terminals (See Williams Paragraphs 152 and 153); wherein said processor is adapted to generate duty and tax refund claims based upon receipt of returned item data (See Williams Paragraphs 187 - 199, 204, 253 and 254, additional components of refund are interpreted to include duty also); wherein said processor is operative to add returned item information to said database if items from a package are returned to the Sender, and to prepare duty and tax refund claims based on the returned item information (See Williams Paragraphs 187 - 199, 204, 253 and 254, additional components of refund are interpreted to include duty also); and wherein said processor is operative to add shipment tracking data to said database and correlate the package data in the database with the shipment tracking data (See Williams Paragraphs 148 - 150).

With reference to claim 17, Riggs teaches shipping documents comprising customs forms (See Riggs Paragraphs 55 and 88).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.



Art Unit: 3624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian

June 17, 2004

Richard Weisberger

Primary Examiner



**VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600**